

REMARKS

At the outset, Applicants wish to thank Examiner R. Gleitz for the courtesies extended to Applicants' representatives during their telephonic interview on January 31, 2007. The substance of the interview is incorporated in the following remarks.

Summary of the Office Action

In the Office Action, claim 1, 19, 21, and 22 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Japanese Patent No: JP-403079519A to *Ishihara*.

Claims 1-5, 11, and 18 stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated by Japanese Patent No: JP-06247569A to *Ohashi*.

Claims 1-5, 11, and 18-22 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Ohashi*.

Claims 1-5, 11, and 18-22 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Ohashi* in view of the *APA*.

Claims 6 and 12 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Ohashi* in view of *Ishihara*.

Claim 10 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Ohashi* in view of Japanese Patent No: JP-2000122362A to *Ishio et al.* ("*Ishio*").

Claim 7 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all the features of the base claim and any intervening claims.

Summary of the Response to the Office Action

Applicants respectfully submit that the features of the present invention are not taught or suggested by the applied references of record. Claims 8-9 have been withdrawn. Claims 13-17 have been cancelled without prejudice or disclaimer. Accordingly, claims 1-12 and 18-21 are pending for further consideration.

All Subject Matter Complies with 35 U.S.C. § 102(b)

In the Office Action, claims 1, 19, 21, and 22 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Japanese Patent No: JP-403079519A to *Ishihara*. This rejection is respectfully traversed.

Applicants respectfully submit that the Office Action has not established that *Ishihara* anticipates each and every feature of Applicants' claimed invention and that all rejections under 35 U.S.C. § 102(b) should be withdrawn. Namely, Applicants contend that independent claim 1 recites "a sheet storing portion that sequentially feeds recording sheets to said image forming portion, said sheet storing portion comprising at least one sheet tray that stores a stack of recording sheets and is horizontally movable in two directions, which intersect with each other." And similarly, independent claim 21 recites, "a sheet storing portion . . . is horizontally movable in first and second directions, which intersect with each other." Applicants respectfully submit that *Ishihara* only discloses one sheet tray that is horizontally movable in only one direction.

The Office Action asserts that the tray of the *Ishihara* is "movable in both of two directions, relative to the main body of the image forming apparatus that are orthogonal to each other, as shown in figures 7 and 9." First of all, the Office Action is quoting claim language that

is absent from claims 1 and 21. Secondly, the Office Action is pointing to two separate embodiments to try to assert that *Ishihara* is movable in two directions which intersect with each other. Applicants respectfully submit that the two embodiments in *Ishihara*, represented by Figs. 7 and 9, both only operate horizontally in one direction. In Fig. 7, the sheet tray (4) moves in and out of the main body to the front side of the image forming apparatus. In Fig. 9, the sheet tray (4) moves in and out of the main body to the left side of the image forming apparatus. The sheet trays translate in and out of the main body, but do not intersect each other because they are in different embodiments. As such, Applicants respectfully assert that the rejection under 35 U.S.C. § 102(b) should be withdrawn because the *Ishihara* does not teach or suggest each feature of independent claims 1 and 21.

Further, during the interview with Examiner Gleitz, he stated that arrows J and K as shown in Fig. 8 of *Ishihara* show the sheet tray “horizontally movable in two directions, which intersect with each other.” However, the Examiner’s assertions are not correct because arrow J shows the direction of travel of feeding paper, and arrow K shows the pull-out direction of the sheet tray. Thus, *Ishihara* does not disclose the features asserted by Examiner Gleitz.

Additionally, Applicants respectfully submit that dependent claims 19 and 22 also are allowable insofar as they recite the patentable combinations of features recited in claims 1 and 21, as well as reciting additional features that further distinguish over the applied prior art.

Claims 1-5, 11 and 18-22 are rejected under 35 U.S.C. § 102(b) as allegedly anticipated by *Ohashi*. This rejection is respectfully traversed.

Applicants respectfully submit that the Office Action has not established that *Ohashi* anticipates each and every feature of Applicants' claimed invention and that all rejections under 35 U.S.C. § 102(b) should be withdrawn. Namely, Applicants contend that independent claim 1 recites "the main body of the image forming apparatus comprises a plurality of openable covers on a front side wall thereof, and at least a part of said transport path is exposed by opening at least one of the plurality of openable covers." And similarly, independent 21 recites "a plurality of openable covers, wherein at least one of the plurality of openable covers is opened, at least a part of the transport path is exposed to an outside of the image forming apparatus in the first direction." At least these features are not disclosed or taught by *Ohashi*.

The Office Action asserts that *Ohashi* discloses a cover on the front side of Fig. 1 (no reference numeral is assigned) with features similar to that shown by part 111 in Figs. 25 and 26. Applicants respectfully disagree. Part 111 in Figs. 25 and 26 is not a cover, but actually is a manual paper feed portion for inserting paper into the image forming apparatus. A previously submitted machine translation of JP 06-247569 A ("*Ohashi*") from the Japanese Patent Office (JPO) indicates that part 111 as shown in Fig. 25 is the [pressure plate and 111] of the manual bypass sections. See ¶ 0002 of the attached JPO machine translation. Further, part 111 is not located "on a front side wall thereof" of the main body of the image forming apparatus as recited in claim 1.

The Office Action appears to be asserting that these two rectangular shapes of *Ohashi* (unnumbered rectangle in Fig. 1 and part 111 in Fig. 25) are equivalent despite evidence to the contrary. For example, the Office Action points to the unnumbered rectangle on the front surface of Fig. 1 of *Ohashi* as being the recited openable cover. However, the JPO machine translation of the specification does not discuss or even mention the feature in Fig. 1. Nevertheless, the comments in the Office Action make the unsubstantiated assertion that the unnumbered rectangle on the front surface of Fig. 1 is a cover as recited in the claims.

The Office Action impermissibly combines the two separate embodiments (Fig. 1 and Fig. 25) to suggest that together they both disclose covers, albeit on different sides. Applicants respectfully submit that these unsubstantiated assertions cannot be considered to be anticipatory of the present invention. Therefore, *Ohashi* does not disclose the cover on a front side wall and cannot anticipate the invention recited in claims 1 and 21. If the rejection is maintained, the Examiner is asked to provide the basis for asserting that these unnumbered rectangular areas are openable covers.

Additionally, Applicants respectfully submit that dependent claims 2-5 and 18-20 are also allowable insofar as they recite the patentable combinations of features recited in claims 1 and 21, as well as reciting additional features that further distinguish over the applied prior art.

Further, Applicants respectfully submit that independent claim 11 recites “said transport path is provided to run from one tray and penetrate through the other trays in the vertical direction,” and at least these features are not disclosed, taught, or suggested by *Ohashi*. *Ohashi* does not show the transport path running through trays stacked in a vertical direction. Because

Ohashi does not disclose this, it cannot anticipate the invention recited in claim 11.

Applicants respectfully submit that the Office Action has not established that *Ohashi* anticipates each and every feature of Applicants' claimed invention in claim 11 and that all rejections under 35 U.S.C. § 102(b) should be withdrawn. Namely, Applicants contend that independent claim 11 recites "the direction in which the sheet tray is pulled out coincides with the direction in which said recording sheets are fed, and the sheet tray is movable in two directions substantially orthogonal to each other," (emphasis added). At least these features are not disclosed or taught by *Ohashi*.

The Office Action does not address the claim 11 features of "the direction in which the sheet tray is pulled out coincides with the direction in which said recording sheets are fed." That is, the Office Action simply assumes erroneously that this claim limitation is met by *Ohashi*. Applicants respectfully submit that these unsubstantiated assertions cannot be considered to be anticipatory of the present invention. Therefore, *Ohashi* does not disclose these features and cannot anticipate the invention recited in independent claim 11.

As pointed out in MPEP § 2131, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987). Therefore, Applicants respectfully assert that the rejection under 35 U.S.C. § 102(b) should be withdrawn because *Ohashi* does not teach or suggest each feature of independent claim 11.

All Subject Matter Complies with 35 U.S.C. § 103(a)

Claims 1-5, 11, and 18-22 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Ohashi*. This rejection is respectfully traversed.

As demonstrated above, the Office Action has not established a *prima facie* case of obviousness at least because *Ohashi*, whether alone or in combination, does not teach or suggest all the recited features of independent claims 1, 11, and 21. As pointed out in M.P.E.P. § 2143.03, “[t]o establish prima facie obviousness of a claimed invention, all the claimed limitations must be taught or suggested by the prior art”. *In re Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974). As such, Applicants respectfully assert that *prima facie* obviousness has not been met. Therefore, Applicants respectfully request that the rejection under 35 U.S.C. § 103(a) should be withdrawn because *Ohashi* does not teach or suggest each and every feature of independent claims 1, 11, and 21.

Additionally, Applicants respectfully submit that dependent claims 2-5 and 18-20 are also allowable insofar as they recite the patentable combinations of features recited in claims 1 and 21, as well as reciting additional features that further distinguish over the applied prior art.

Claims 1-5, 11, and 18-22 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Ohashi* in view of *APA*. As demonstrated above, the Office Action has not established a *prima facie* case of obviousness at least because *Ohashi*, whether alone or in combination with the *APA*, does not teach or suggest all the recited features of independent claims 1, 11, and 21. The covers, allegedly taught by the *APA* in Fig. 22 and relied upon, are actually shown on the side wall of the image forming apparatus and not on a front side wall as

recited in independent claim 1. Thus, Applicants respectfully submit that the Office Action has not established that the *APA* overcomes the deficiencies identified in *Ohashi*. The *APA* only discloses features of “conventional apparatuses include a paper transport path on a lateral side of the apparatus, and therefore the paper path provided along the side surface of the apparatus must be opened to remove a sheet stuck in the path upon a paper jam,” as stated in the specification at page 4, lines 15-18.

As pointed out in M.P.E.P. § 2143.03, “[t]o establish prima facie obviousness of a claimed invention, all the claimed limitations must be taught or suggested by the prior art”. *In re Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974). As such, Applicants respectfully assert that *prima facie* obviousness has not been met. Therefore, Applicants respectfully request that the rejection under 35 U.S.C. § 103(a) should be withdrawn because *Ohashi* and the *APA*, whether combined or alone, do not teach or suggest each and every feature of independent claims 1, 11, and 21.

Additionally, Applicants respectfully submit that dependent claims 2-5 and 18-20 are also allowable insofar as they recite the patentable combinations of features recited in claim 1, as well as reciting additional features that further distinguish over the applied prior art.

Claims 6 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ohashi* in view of *Ishihara*. This rejection is respectfully traversed.

The Office bears the initial burden of establishing a *prima facie* case of obviousness. M.P.E.P. § 2142. If the Office fails to set forth a *prima facie* case of obviousness, Applicant is under "no obligation to submit evidence of nonobviousness," such as unexpected results or

commercial success. *Id.* In other words, if the Office fails to meet the initial burden of establishing a *prima facie* case of obviousness as to a given claim, then that claim is not obvious without any evidence of nonobviousness by the Applicant.

In the present case, neither *Ohashi* nor *Ishihara*, either alone or in combination teaches or suggests at least the features of “the main body of the image forming apparatus comprises a plurality of openable covers on a front side wall thereof, and at least a part of said transport path is exposed by opening at least one of the plurality of openable covers,” as recited in independent claim 1, and the features of “the direction in which the sheet tray is pulled out coincides with the direction in which said recording sheets are fed, and the sheet tray is movable in two directions substantially orthogonal to each other,” as recited in independent claim 11 (emphasis added), from which claims 6 and 12 depend, respectively.

With respect to claim 6, *Ishihara* does not make up for the deficiencies of *Ohashi*. That is, *Ishihara* does not teach or suggest an image forming apparatus with a plurality of openable covers on a front side wall as recited in claim 1. Thus, the Office Action has not established a *prima facie* case of obviousness at least because neither *Ohashi* nor *Ishihara*, whether alone or in combination, teach or suggest all the recited features of independent claim 1 from which claim 6 depends.

Further, *Ishihara* also does not make up for the deficiencies of *Ohashi* because *Ishihara* does not teach or suggest an image forming apparatus with a “sheet storing portion comprising at least one sheet tray that stores a stack of recording sheets and is horizontally movable in two directions, which intersect with each other,” as in claim 1. Thus, the Office Action has not

established a *prima facie* case of obviousness at least because neither *Ohashi* nor *Ishihara*, whether alone or in combination, teach or suggest all the recited features of independent claim 1 from which claim 6 depends.

With respect to claim 12, *Ishihara* does not make up for the deficiencies of *Ohashi*. That is, *Ishihara* does not teach or suggest the features of “the direction in which the sheet tray is pulled out coincides with the direction in which said recording sheets are fed, and the sheet tray is movable in two directions substantially orthogonal to each other,” as recited in independent claim 11 (emphasis added). Thus, the Office Action has not established a *prima facie* case of obviousness at least because neither *Ohashi* nor *Ishihara*, whether alone or in combination, teach or suggest all the recited features of independent claim 11, from which claim 12 depends.

As pointed out in M.P.E.P. § 2143.03, “[t]o establish prima facie obviousness of a claimed invention, all the claimed limitations must be taught or suggested by the prior art”. *In re Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974). As such, Applicants respectfully assert that *prima facie* obviousness has not been met. Because the Office Action fails to meet a *prima facie* case of obviousness, Applicants respectfully request that the rejection of claims 6 and 12 under 35 U.S.C. § 103(a) be withdrawn.

Claim 10 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Ohashi* in view of *Ishio*. This rejection is respectfully traversed.

Applicants respectfully submit neither *Ohashi* nor *Ishio*, either alone or in combination teaches or suggests at least the features of “the main body of the image forming apparatus comprises a plurality of openable covers on a front side wall thereof, and at least a part of said

transport path is exposed by opening at least one of the plurality of openable covers,” as recited in claim 1, from which claim 10 depends. Thus, the Office Action fails to establish a *prima facie* case of obviousness as to claim 10.

Ishio does not make up for deficiencies previously demonstrated in *Ohashi*. Accordingly, it is respectfully submitted that the rejection is in error. Withdrawal of the rejection under 35 U.S.C. § 103(a) over *Ohashi* in view of *Ishio* is respectfully requested. Claim 10 is also allowable at least because it recites the same combination of features as independent claim 1, as well as the additional features it recites that further distinguish them over the applied art.

Further, *Ishio* also does not make up for the deficiencies of *Ohashi* because *Ishio* does not teach or suggest an image forming apparatus with a “sheet storing portion comprising at least one sheet tray that stores a stack of recording sheets and is horizontally movable in two directions, which intersect with each other,” as in claim 1. Thus, the Office Action has not established a *prima facie* case of obviousness at least because neither *Ohashi* nor *Ishio*, whether alone or in combination, teach or suggest all the recited features of independent claim 1 from which claim 10 depends.

For the same reasons above-mentioned, it is respectfully submitted that none of the references of record teach or suggest the features of Applicants pending claims. In view of the above arguments, Applicants respectfully request that the rejection of claim 10 under 35 U.S.C. §103(a) be withdrawn.

CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration and allowance of all pending claims.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

EXCEPT for issue fees payable under 37 C.F.R. § 2.28, the Commission is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to to our Deposit Account No. 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP

Dated: February 26, 2007

By: 

David E. Connor
Reg. No. 59,868

CUSTOMER NO. 09629
MORGAN, LEWIS & BOCKIUS LLP
1111 Pennsylvania Avenue, N.W.
Washington, D.C. 20004
Telephone: (202) 739-3000
Facsimile: (202) 739-3001